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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/376,461	08/18/1999	DAVID WINDSOR RILLIE	1128.006A	6542
7590 07/17/2006			EXAMINER	
JOHN L ROGITZ ESQ ROGITZ & ASSOCIATES 750 B STREET SUITE 3120 SAN DIEGO, CA 92101			CHILCOT, RICHARD E	
			ART UNIT	PAPER NUMBER
			3634	

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/376,461	Applicant(s) RILLIE, DAVID WINDSOR	
	Examiner Richard E. Chilcot	Art Unit 3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/10/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4,7,8 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,4,7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

With respect to applicant's arguments that none of the cited references to Chao et al., Nagler et al., or Duetsch teach or suggest, alone or in combination, the skylight and roof flashing of the instant application, the examiner fully agrees. However, in view of the reference to Schindler (1,721,715), which is considered the best prior art, the following rejections have been applied.

Election/Restriction

Claims 10-15 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 2 and affirmed in Paper No. 3.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 7 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schindler (1,721,715).

Schindler teaches a roof flashing comprising one piece (lines 17-20) having a frustro-conical shaped curb (lines 66-70), a metal skirt (10) extending radially from the bottom end, and a plurality of strengthening ribs (14-16) extending radially outwardly from the opening.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schindler in view of Powell. As noted herein above, Schindler teaches the roof flashing of the instant invention with the exception of at least one rib formed along at least part of the periphery of the skirt. On the other hand, Powell teaches a skylight flashing (12) having a plurality of ribs (17) formed along at least part of the periphery of the skirt (16). Accordingly, to provide at least one rib formed along at least part of the periphery of the skirt of Schindler, as taught by Powell, would have been obvious for one having ordinary skill in the art at the time the invention was made. The motivation for this modification would have been to provide an enhanced water protection for the skylight.

Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Chao et al in view of Schindler.

Chao et al. clearly disclose that the basic tubular skylight construction of a metal flashing, transparent dome and at least one skylight tube as set forth in claim 1 is old and well known. Applicant's attention is invited to Fig. 1 and Col. 2, lines 35- 38. The fact that the flashing is metal is clearly established in Col. 4, line 67. What Chao et al. fail to disclose is that the metal flashing is seamless. On the other hand, Schindler teaches a roof flashing comprising one piece (lines 17-20) having a frusto-conical shaped curb (lines 66-70), a metal skirt (10) extending radially from the bottom end, and a plurality of strengthening ribs (14-16) extending radially outwardly from the opening. Accordingly, to form the flashing of Chao et al., as suggested by Schindler, would have been obvious for one having ordinary skill in the art at the time of the invention. The motivation for such a modification would have been to provide a flashing that is completely waterproof, cheap to manufacture and more durable than multiple piece flashings.

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Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chao et al in view of Schindler as applied to claim 3 above, and further in view of Powell. As noted herein above, the combination of Chao et al. and Schindler teach the skylight and roof flashing of the instant invention with the exception of at least one rib formed along at least part of the periphery of the skirt. On the other hand, Powel teaches a skylight flashing (12) having a plurality of ribs (17) formed along at least part of the periphery of the skirt (16). Accordingly, to provide at least one rib formed along at least part of the periphery of the skirt of Chao et al., as taught by Powell, would have been obvious for one having ordinary skill in the art at the time the invention was made. The motivation for this modification would have been to provide an enhanced water protection for the skylight.

Response to Arguments

Applicant's arguments with respect to claims 3, 4, 7 and 8 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

It is suggested to the applicant to present a claim that embodies the combination of the tubular skylight and the flashing (claims 3 and 4) including the following features: (1) the curb does not include the strengthening ribs and (2) the skirt does not extend beyond the peripheral rib.

Conclusion

The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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Commissioner for Patents
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Signature: _____

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Certificate of Transmission

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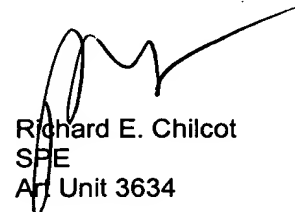
Typed or printed name of person signing this certificate:

Signature: _____

Registration Number: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile
transmissions and mailing, respectively.

Any inquiry concerning this communication should be directed to Richard E. Chilcot at
telephone number (571) 272-6777.


Richard E. Chilcot
SPE
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